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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,520	12/07/2000	John Roderick Morrison	14390	1130

7590 10/16/2003

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Garden City, NY 11530

EXAMINER

FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

19

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/732,520

Applicant(s)

MORRISON ET AL.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☐ The proposed amendment(s) will not be entered because:
 (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 45-62

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
 10. ☐ Other: _____

Anne-Marie Falk

Anne-Marie Falk, Ph.D.

Primary Examiner

Art Unit: 1632

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of Claims 57 and 62 under 35 U.S.C. 112, second paragraph and the objections to the specification.

Continuation of 5. does NOT place the application in condition for allowance because:

With regard to the Morrison Declaration filed July 18, 2003, Applicants are reminded that declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are not considered timely when filed after a final rejection, unless submitted in response to a new ground of rejection made in the final rejection. In this case, no new ground of rejection was made in the final rejection. See MPEP 716.01.

Paragraphs 9-11 of the Declaration have been considered and overcome the objections to the specification set forth at pages 2-3 of the Office Action of Paper No. 16 (mailed 5/12/03). See Item 3 above. The remainder of the Declaration has not been considered as it is directed to presenting new evidence traversing the enablement rejection.

Applicants' response has been fully considered where it does not rely on the additional evidence submitted after final rejection.

With regard to the enablement rejection, Applicants argue that Westhusin et al. do not teach that there is any major difference in nuclear transfer steps in a cloning procedure. Applicants argue that the basic approach involving nuclear transfer is similar and includes six steps in all animal species. Applicants further argue that the techniques that are required to accomplish each of these steps vary slightly between species. However, these slight variations markedly affect the success or failure of the cloning protocol. There are no general guidelines for determining which modifications, no matter how large or small, are required to come up with a successful cloning protocol for a new species. Westhusin et

Art Unit: 1632

Continuation Sheet (PTOL-303)

al. emphasizes that “[w]hile the basic approach involving nuclear transfer may be similar, the specific materials and methods utilized for cloning one species of animal do not automatically apply across different species” (page 36, paragraph 4). Westhusin et al. further points out that “[c]loning a particular animal in order to reproduce a specific genotype can be an extremely challenging venture” (page 36, paragraph 3). The references cited in the previous Office Actions demonstrate that the field of somatic cell nuclear transfer as a whole is still in its infancy. The technical steps of nuclear transfer are complex, and minor variations in any of a number of parameters can easily impede success.

Claims 45-62 remain rejected under 35 U.S.C. 112, first paragraph, for reasons of record.